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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/534,433	03/23/00	PATTON	805211-1

001333
PATENT LEGAL STAFF
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EXAMINER
HENDERSON, M

ART UNIT
3722

PAPER NUMBER

DATE MAILED: 11/3/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/534,433

Applicant(s)
David L. Patton

Examiner
Mark T. Henderson

Group Art Unit
3722



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-33 is/are pending in the application.

Of the above, claim(s) 1-11 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 12-33 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, are drawn to a method of printing stamps, classified in class 101, subclass 2.
 - II. Claims 12-33, are drawn to a stamp and stamp sheet product, classified in class 283, subclass 22.

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2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as by printing an image receiving medium utilizing ink jet printing wherein the image is directly printed on the envelope.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Attorney Milton Sales on October 2000 a provisional election was made without traverse to prosecute the invention of Group I, claims 12-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. In Claim 15 and 26, it is not understood what is meant by the phrase "that said limited edition stamp one out of a predetermined amount." Appropriate correction is required.
7. Claim 16 recites the limitation "the eye" in line 2. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 17 recites the limitation "said second indicia is not capable of being scanned" in line 2. There is insufficient antecedent basis for this limitation in the claim. The specification on page 5, states that the second indicia can not be scanned for reproduction, but can be read under special viewing conditions.
9. Claim 19 recites the limitation "the printer" in line 2. There is insufficient antecedent basis for this limitation in the claim.
10. In Claims 19 and 30, "and/or" renders the scope of the claim to be unclear.

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11. Claim 20 recites the limitation "the eye" in line 2. There is insufficient antecedent basis for this limitation in the claim.
12. In Claims 22, 29 and 33, line 2, should the phrase "can be seen when view under UV...." be "can be seen when viewed...."? Appropriate correction is required.
13. Claim 21 recites the limitation "said third indicia is not capable of being scanned" in line 2. There is insufficient antecedent basis for this limitation in the claim.
14. Claim 27 recites the limitation "the eye" in line 2. There is insufficient antecedent basis for this limitation in the claim.
15. Claim 28 recites the limitation "said second indicia is not capable of being scanned" in line 2. There is insufficient antecedent basis for this limitation in the claim.
16. Claim 30 recites the limitation "the printer" in line 2. There is insufficient antecedent basis for this limitation in the claim.
17. Claim 31 recites the limitation "the eye" in line 2. There is insufficient antecedent basis for this limitation in the claim.
18. Claim 32 recites the limitation "said third indicia is not capable of being scanned" in line 2. There is insufficient antecedent basis for this limitation in the claim.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 12-22, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore et al (5,943,432).

Gilmore et al discloses in Fig. 3 and 4, a stamp comprising a first indicia (125) and a second indicia (152), wherein either the first or second indicia can be invisible under normal viewing conditions, unscannable (as stated in Col. 4, line 64, "UV characteristics which may be detected by a compatible reader") and has an ink which can be seen under UV light (as stated in Col. 4, lines 62-67).

However, Gilmore et al does not disclose a first and second indicia identifying stamp as a valid limited edition, first indicia being a visible unique ID, a third indicia wherein the indicia is invisible to the eye, unscannable and derived from ink that can be seen under UV or infrared light.

In regards to **Claims 12, 13, 15 and 19**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia since it would only depend on the intended use of the assembly and the desired information to be

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displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

In regards to **Claims 19, 20 and 22**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any number of indicia, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

20. Claims 23-33, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Brasington et al (5,923,406) in view of Gilmore et al (5,943,432).

Brasington et al discloses in Fig. 5 and 8, a sheet of stamps, each stamp comprising a first visible indicia (69), a second indicia (73), and a third indicia (71) provided for identifying the vendor/printer machine (Col. 5, lines 11-34) and location.

However, Brasington et al does not disclose a first and second indicia which identifies a stamp to be a limited edition, a second indicia which is invisible under normal viewing and is made using an ink that can be seen under UV or infrared light, a first indicia comprising a unique ID, and a third invisible indicia made with ink that can be seen when viewed by UV or infrared light.

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Gilmore et al discloses in Fig. 3 and 4, a stamp comprising a first indicia (125) and a second indicia (152), wherein either the first or second indicia can be invisible under normal viewing conditions, unscannable (as stated in Col. 4, line 64, "UV characteristics which may be detected by a compatible reader") and has an ink which can be seen under UV light (as stated in Col. 4, lines 62-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brasington et al's stamp sheet to include stamps having indicia which can only be seen under UV conditions as taught by Gilmore et al for the purpose of determining whether the correct postage has been applied to a postal letter.

In regards to **Claims 23, 24, 26 and 30**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

In regards to **Claims 27-33**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any number of indicia, since it has been held

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that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

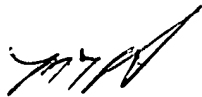
Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Gray et al, Berson et al, Gunn, Beaudoin et al, Paz-Pujalt et al, Henderson and Kaplan disclose stamp structure with multiple indicia.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 27, 2000



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